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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,854	10/06/2000	Christopher Kelly	98R-2-2	9855
29500	7590	10/07/2003	EXAMINER	
RAININ INSTRUMENT, LLC			LUDLOW, JAN M	
7500 EDGEWATER DRIVE			ART UNIT	
OAKLAND, CA 94621-3027			PAPER NUMBER	
			1743	

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

0013

Office Action Summary

Application No.

09/680,854

Applicant(s)

KELLY ET AL.

Examiner

Jan M. Ludlow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Williams.

Williams teaches a pipette shaft having a cylindrical sealing zone (either of the portions 276 or 279 below the point of contact at part 274 of the pipette tip) with a spaced cylindrical support zone above or below the point of contact at either part 274 or 276 of the pipette tip. The annular sealing rings have a first predetermined diameter and the spaces above and below them have differing predetermined diameters. It is the examiner's position that the seal is airtight in that if the seal leaked, the pipette would not function. With respect to the functional limitation to minimizing ejection forces, it is the examiner's position that the forces are minimized as compared to a tip that contacts the shaft at all surfaces.

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4. Brysch additionally teaches a pipette shaft and tip in which a portion 4 of the shaft is smaller than the inner diameter of the tip in a region spaced from the sealing region 5. Applicant has defined "substantially cylindrical" as having a taper of 1.5 degrees or less (p. 27) and it is not clear that either of section 4 or 5 meet this definition.

5. Applicant's arguments filed July 24, 2003 have been fully considered but they are not persuasive.

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6. Applicant argues that Williams teaches that the alignment ring on the pipette tip contacts the pipette shaft, but this is not the basis of the rejection. The rejection relies on the portions of the pipette tip adjacent the alignment ring, which are quite clearly shown in the figures to be spaced from the pipette shaft. Applicant argues that the portions of the pipette tip adjacent the alignment ring cannot function as lateral support zones because the two sealing rings prevent rocking. While the examiner acknowledges that the lateral support zones are disclosed as preventing rocking (see, e.g., page 14, line 14 ad page 29, lines 4-5 of the instant disclosure), the claimed structure corresponding to the lateral support zones is found in Williams. There are no claim limitations precluding the alignment ring or second seal, and no functional limitation requiring that the pipette tip is "rockable" about the sealing zone/region, the lateral support zone/region preventing such rocking. Further, even in the tip of Williams, where the alignment ring provides the primary anti-rocking function, the spaced walls adjacent the alignment ring would inherently provide a secondary alignment/support function. The examiner notes that the claims may be amended to define over the tip/shaft combination of Williams by precluding the alignment ring using language consistent with the instant disclosure.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (703) 308-4039. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jan M. Ludlow
Primary Examiner
Art Unit 1743

Jml

10/4/2003